

AMENDMENTS TO THE DRAWINGS:

Subject to the approval of the Examiner, please replace the drawing sheet containing FIG. 1 in this application with the replacement drawing sheet filed herewith (labeled “Replacement Sheet” and containing FIG. 1). The replacement drawing addresses the Examiner’s objection set forth in the Office Action. The changes to the drawing are discussed in the **Remarks** below.

Attachment: Replacement Drawing Sheet (1 sheets, FIG. 1).

REMARKS

By this Amendment, Applicants amend claims 1, 10, 19-22, 25, and 26. Claims 1-27 remain pending in this application. In the Office Action of March 25, 2005,¹ the drawings were objected to; claims 10 and 19 were objected to for informalities; claims 1-9, 21, and 24-27 were rejected under 35 U.S.C. § 112, first paragraph, as failing to comply with the enablement requirement; claims 1-9 and 21-27 were rejected under 35 U.S.C. § 112, second paragraph, as failing to set forth the subject matter Applicants regard as their invention; claims 19 and 20 were rejected under 35 U.S.C. § 112, second paragraph, as being indefinite, claims 1-9 and 27 were rejected under 35 U.S.C. § 102(e) as anticipated by U.S. Patent Application Pub. No. 2003/0079197 ("*Pannala*"); and claim 24 was rejected under 35 U.S.C. § 103(a) as unpatentable over *Pannala*. Applicants appreciate the Examiner's indication of allowable subject matter and address the objections and rejections below.

¹ The Office Action contains a number of statements reflecting characterizations of the related art and the claims. Regardless of whether or not any such statement is identified herein, Applicants decline to automatically subscribe to any statement or characterization in the Office Action.

Objection to FIG. 1

The Examiner objected to the drawings because FIG. 1 “on the paper is skewed” and not “parallel to the paper boundaries” (Office Action “OA” at 2). Applicants submit herewith a replacement drawing sheet, containing FIG. 1, addressing the Examiner’s objection. Applicants deem the objection to the drawings overcome by the submission of the replacement drawing sheet and thus request withdrawal of the objection.

Applicants request that the replacement drawing be made of official record in the above-identified application. If the replacement drawing for any reason is not in full compliance with the pertinent statutes and regulations, please so advise the undersigned.

Objection to claims 10 and 19

The Examiner objected to claims 10 and 19 for informalities (Office Action “OA” at 3). Applicants submit that the Examiner’s objection is addressed and overcome by the amendments to claims 10 and 19 made herein. Applicants therefore request withdrawal of the objection.

With the objection to claim 10 having been overcome, Applicants submit that claims 10-18 are in *prima facie* condition for allowance. Applicants therefore request the timely allowance of these pending claims.

Rejection of claims 1-9, 21, and 24-27 under 35 U.S.C. § 112, first paragraph

The Examiner alleged that claims 1-9, 21, and 24-27 contain subject matter that “was not described in the specification in such a way as to enable one skilled in the art . . . to make and/or use the invention” (OA at 3-4). The Examiner alleged, that “Applicants’ specification is directed toward a method for designing a system; the system includes an element” (OA at 4). According to the Examiner, Applicants’ specification does not enable “a method for designing an element” and the feature of “establishing guidelines for designing an element” (OA at 4). Applicants traverse the rejection of claims 1-9, 21, and 24-27 for the following reasons.

The test for enablement is whether the disclosure contains sufficient information to enable one reasonably skilled in the pertinent art to make and use the claimed invention without “undue experimentation.” M.P.E.P. § 2164.01. As the M.P.E.P. makes clear, “[i]n order to make [an enablement] rejection, the examiner has the initial burden to establish a reasonable basis to question the enablement provided for the claimed invention.” M.P.E.P. § 2164.04 (internal citations omitted). The Examiner’s conclusions regarding enablement should be based on specific findings of fact that are supported by evidence. *See id.*

In this case, the Examiner has not satisfied the initial burden to establish a reasonable basis to question enablement. The Examiner’s allegations are conclusory and not supported by evidence.

The lack of a *prima facie* showing notwithstanding, Applicants submit that claims 1-9, 21, and 24-27 are enabled. Contrary to the Examiner’s position, the subject matter recited in Applicants’ claims regarding “designing an element” is enabled by the specification. In fact, on page 6, ¶ 20, the specification states: “Fig. 2 illustrates an exemplary flow chart of a method for designing a routing element” (emphasis added). Given Applicants’ specification (see, e.g., Fig. 2; page 4, ¶¶ 14-15; pages 6-8, ¶¶ 20-23) and the claim language itself, undue experimentation would not be required to implement and use a method of “designing an element” including “establishing guidelines for designing the element,” as claimed.²

For at least the foregoing reasons, Applicants request withdrawal of the rejection of claims 1-9, 21, and 24-27 under 35 U.S.C. § 112, first paragraph.

² In referring to the specification, Applicants do not intend to limit the scope of the claims to the exemplary embodiments shown in the drawings and described in the specification. Rather, Applicants expressly affirm their entitlement to have the claims interpreted broadly, to the maximum extent permitted by statute, regulation, and applicable case law.

Rejection of claims 1-9 and 21-27 under 35 U.S.C. § 112, second paragraph

Applicants traverse the rejection of claims 1-9 and 21-27 under 35 U.S.C. § 112, second paragraph, for the following reasons.

The Examiner alleged that “Applicants’ invention involves a method of designing a system that includes an element, not a method of designing an element” (OA at 4). Applicants disagree with the Examiner’s allegation. In fact, on page 6, ¶ 20, the specification states: “Fig. 2 illustrates an exemplary flow chart of a method for designing a routing element” (emphasis added). Furthermore, in rejecting claim 22, the Examiner mischaracterizes the recitations of the claim. Claim 22 recites a “method of routing an element,” not a method of designing an element.

Applicants submit that claims 1-9 and 21-27 are fully compliant with § 112, second paragraph, and request withdrawal of the rejection. Further, because all of the outstanding rejections of claims 21, 22, 25, and 26 should be withdrawn, Applicants request the timely allowance of these pending claims.

Rejection of claims 19 and 20 under 35 U.S.C. § 112, second paragraph

The Examiner rejected claims 19 and 20 as being indefinite. Applicants submit that claims 19 and 20, as amended herein, are fully compliant with § 112, second paragraph. Applicants therefore request withdrawal of the objection. With the § 112 rejection of claims 19 and 20, as well as the objection to claim 19, having been overcome, Applicants submit that claims 19 and 20 are in *prima facie* condition for allowance. Applicants therefore request the timely allowance of these pending claims.

Rejection of claims 1-9 and 27 under 35 U.S.C. § 102(e)

Applicants traverse the rejection of claims 1-9 and 27 under § 102(e) because *Pannala* fails to anticipate the claims. In order to properly anticipate Applicants’ claimed invention under 35 U.S.C. § 102, each and every element of the claim at issue must be found, either expressly

described or under principles of inherency, in a single prior art reference. Further, “[t]he identical invention must be shown in as complete detail as is contained in the . . . claim.” *See* M.P.E.P. § 2131. Finally, “[t]he elements must be arranged as required by the claim.” *Id.*

With regard to independent claim 1, *Pannala* does not teach at least “establishing guidelines for designing the element, the guidelines including information reflecting attributes of the system and the element,” as currently claimed. Although *Pannala* discloses providing a netlist, which is “a collection of information identifying component pairs and their interconnection” to a symbol generator, producing a layout based on the netlist, and producing a wiring diagram according to the layout (§ 0018; Figs. 1, 4, and 5 and accompanying text), *Pannala* does not teach “establishing guidelines,” as recited in claim 1. Indeed, neither the relied upon disclosure in *Pannala* (e.g., §§ 0018, 0022, 0026), nor any other disclosure in the reference, teaches the “establishing guidelines” feature of claim 1.

Because *Pannala* does not teach each and every element of claim 1, as a matter of law, it cannot anticipate this claim. As such, the rejection of claim 1 under 35 U.S.C. § 102(e) based on *Pannala* should be withdrawn. Claims 2-9 and 23 depend upon claim 1 and are distinguishable from *Pannala* for at least reasons similar to those presented above in connection with claim 1. Accordingly, Applicants request withdrawal of the § 102(e) rejection and the timely allowance of claims 1-9 and 23.

With regard to independent claim 27, *Pannala* fails to disclose at least “establishing guidelines for designing the element, the guidelines including at least information reflecting a geometry of the system.” While *Pannala* discloses producing a layout along a wiring harness layout dimension (see, e.g., §§ 0004, § 0018), the reference does not disclose “establishing guidelines for designing the element, the guidelines including at least information reflecting a

geometry of the system,” as recited in claim 27. Indeed, neither the relied upon disclosure in *Pannala* (e.g., ¶¶ 0018, 0022, 0026), nor any other disclosure in the reference, teaches the “establishing guidelines” feature of claim 27. Because *Pannala* does not teach each and every element of claim 27, as a matter of law, it cannot anticipate this claim. Applicants therefore request withdrawal of the § 102(e) rejection and the timely allowance of claim 27.

Rejection of claim 24 under 35 U.S.C. § 103(a)

Applicants traverse the rejection of claim 24 under 35 U.S.C. § 103(a) because a case for *prima facie* obviousness has not been established based on *Pannala*. As M.P.E.P. § 2142 states, “[t]he examiner bears the initial burden of factually supporting any *prima facie* conclusion of obviousness.” To establish *prima facie* obviousness under 35 U.S.C. § 103(a), three requirements must be met. First, the applied references, taken alone or in combination, must teach or suggest each and every element recited in the claims. *See* M.P.E.P. § 2143.03 (8th ed. 2001). Second, there must be some suggestion or motivation, either in the reference(s) or in the knowledge generally available to one of ordinary skill in the art, to combine or modify the reference(s) in a manner resulting in the claimed invention. Third, a reasonable expectation of success must exist. Moreover, each of these requirements must “be found in the prior art, and not be based on applicant’s disclosure.” M.P.E.P. § 2143 (8th ed. 2001).

Claim 24 depends upon claim 1 and therefore includes all of the features recited in claim 1. As explained above in connection with claim 1, *Pannala* does not disclose “establishing guidelines for designing the element, the guidelines including information reflecting attributes of the system and the element.” *Pannala* also fails to render this feature obvious. Because the applied reference fails to teach or suggest each and every feature of claim 24, *prima facie* obviousness has not been established with respect to that claim.

Furthermore, as affirmed by the Examiner, *Pannala* does not disclose establishing guidelines for designing an element “by prompting a user to answer one or more questions,” as recited in claim 24 (OA at 7-8). While acknowledging that *Pannala* fails to disclose “prompting a user to answer one or more questions in establishing the guidelines,” the Examiner alleges that “it would have been obvious . . . that establishing guidelines may be created through system prompt/ user input” (OA at 8). According to the Examiner, *Pannala*’s “use of a user interface with input and output devices suggests the possibility of a system prompt and a user response” (OA at 8). Applicants disagree with the Examiner’s interpretation of *Pannala*.

Although Fig. 10 of *Pannala* depicts input and output devices, *Pannala* in no way suggests that such devices are used to establish guidelines for designing an element “by prompting a user to answer one or more questions,” as recited in claim 24. The disclosure of input and output devices does not in and of itself signify that those devices are used to establish guidelines for designing an element “by prompting a user to answer one or more questions,” as claimed. Indeed, *Pannala* is silent about establishing guidelines for designing an element “by prompting a user to answer one or more questions.”

Furthermore, the Examiner’s allegations do not establish that a skilled artisan would have modified *Pannala* to include the features of claim 24 missing from the reference.

Determinations of obviousness must be supported by evidence on the record. *See In re Zurko*, 258 F.3d 1379, 1386 (Fed. Cir. 2001) (finding that the factual determinations central to the issue of patentability, including conclusions of obviousness by the Board, must be supported by “substantial evidence”). The desire to combine or modify references must be proved with “substantial evidence” that is a result of a “thorough and searching” factual inquiry. *See In re Lee*, 277 F.3d 1338, 1343-1344 (Fed. Cir. 2002) (quoting *McGinley v. Franklin Sports, Inc.*, 262

F.3d 1339, 1351-52). Moreover, the Federal Circuit has clearly stated that the evidence of a motivation or suggestion to modify a reference must be “clear and particular.” *In re Dembicziak*, 175 F.3d 994, 999, 50 USPQ2d 1614, 1617 (Fed. Cir. 1999).

In this case, the Office Action does not show, by “clear and particular” evidence, that a skilled artisan considering *Pannala*, and not having the benefit of Applicants’ disclosure, would have been motivated to modify the reference in a manner resulting in Applicants’ claimed combination. The statement that “use of a user interface with input and output devices suggests the possibility of a system prompt and a user response . . .” does not establish a motivation or suggestion for modifying *Pannala*. Applicants call attention to M.P.E.P. § 2143.01, which makes clear that “[t]he mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination” (citations omitted). The Office Action does not show that *Pannala* “suggests the desirability” of a modification resulting the combination of elements recited in claim 24.

Furthermore, as M.P.E.P. § 2141.02 articulates, “[i]n determining the differences between the prior art and the claims, the question under 35 U.S.C. § 103 is not whether the differences themselves would have been obvious, but whether the claimed invention as a whole would have been obvious (internal citations omitted). The Federal Circuit has explained that an examiner may find every element of a claimed invention in the prior art but mere identification is not sufficient to negate patentability. *In re Rouffet*, 149 F.3d 1350, 1357, 47 U.S.P.Q.2d 1453, 1457 (Fed. Cir. 1998). The court explained that “the examiner must show reasons that the skilled artisan, confronted with the same problems as the inventor and with no knowledge of the claimed invention, would select the elements from the cited prior art references for combination in the manner claimed.” *Id.* In this case, the Examiner merely alleged that *Pannala* discloses

certain elements without showing reasons that a skilled artisan would select or modify those elements in the manner claimed and without showing that the claimed invention as a whole would have been obvious. Alleging that certain features “[suggest] the possibility” of modification or a particular use does not suffice to establish a *prima facie* conclusion of obviousness (OA at 8).

Applicants submit that the conclusions in the Office Action were not reached based on facts gleaned from the cited reference and that, instead, teachings of the present application were improperly used to reconstruct the prior art.

For at least the foregoing reasons, the rejection of claim 24 under 35 U.S.C. § 103(a) should be withdrawn. Applicants thus request withdrawal of the § 103(a) rejection of claim 24 and the timely allowance of that claim.

Conclusion

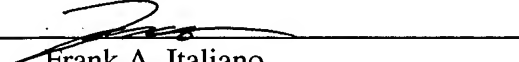
The claimed invention is neither anticipated nor rendered obvious in view of the art cited against this application. Applicants request the Examiner’s reconsideration of the application in view of the foregoing, and the timely allowance of the pending claims.

Please grant any extensions of time required to enter this response and charge any additional required fees to our deposit account 06-0916.

Respectfully submitted,

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Dated: June 27, 2005

By: 
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